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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/752,127 | 12/29/2000 | Ari Nieminen | 4925-100 | 8722 |

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Michael C. Stuart, Esq.
Cohen, Pontani, Lieberman & Pavane
Suite 1210
551 Fifth Avenue
New York, NY 10176

EXAMINER

SRIVASTAVA, VIVEK

| ART UNIT | PAPER NUMBER |
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2611

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,127

Applicant(s)

NIEMINEN, ARI

Examiner

Vivek Srivastava

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17, 21-28, 31, 33 and 35-42 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 18-20, 29, 30, 32 and 34 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5, 7, 10, 11, 13, 15, 17, 21, 22, 24, 26, 28 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Candelore (6,057,872).

Regarding claims 1, 11 and 22, Candelore discloses a system which provides a user with viewing an interactive infomercial which is defined by Candelore as a type of commercial (see col 12 lines 10-22) wherein when a user views the entire commercial a coupon is provide to the user as a reward (see col 12 lines 10-22). It should be noted that the user must also interact with the system to ensure the user is viewing the infomercial (see col 12 lines 47-56, col 16 lines 28-39).

Candelore discloses the infomercial as the first information stream, a second information stream first portion is met by the question asking the viewer if he wishes to continue (see col 12 lines 46-56) and the second portion is met by the coupon (col 12

lines 10-22). It should be noted that consumption of use of the coupon is conditioned upon the user answering the question (see col 12 lines 46-56).

Considering claims 3, 13 and 24 Candelore discloses an informercial as the first stream (see col 12 lines 47-56), a coupon as the second portion of the second information stream (see col 12 lines 8-20 and 47-56), wherein the user is induced to watch the commercial in order to receive the coupon (see col 12 lines 8-20 and 47-56).

Regarding claims 5, 7, 15, 17, 26 and 28 Candelore discloses the coupon is displayed on the TV and thus is a video entity (col 3 lines 53-62).

Regarding claims 10, 21, and 31 Candelore discloses separate transmission paths for the coupon and program services (see col 5 lines 53-55).

Claim 35 is rejected under 35 U.S.C. 102(e) as being anticipated by August et al (5,671,267).

Regarding claim 35, August discloses a handset (col 2 lines 33-38) which captures incoming menu information (see col 5 lines 30-39 and col 6 lines 5-16), noting that menu information meets the claimed "first information stream" and discloses capturing telephone numbers of the advertiser, noting that the telephone numbers meets the claimed "second information stream with first content" (see col 3 lines 25-35). August further teaches the handset can capture "electronic coupons" which meets the claimed "a second information stream with a second portion containing content" (see col 3 lines 25-35). August discloses providing electronic coupons to a user as an incentive to respond to advertisements (col 3 lines 47-55) and thus discloses the claimed

"prompting the user to perform specified interaction and capturing the second content conditionally according to the user's response to said prompting".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 12, 14, 23, 25 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (6,057,872).

Regarding claims 2, 4, 12, 14, 23 and 25, Candelore discloses that the first information stream is a discrete portion of a broadcast (met by infomercial). Candelore fails to disclose the claimed second information stream is arranged so that interaction with the first portion takes a period of time at least substantially equal to the duration of the first information stream, whereby the user is induced to consume substantially the entire first information stream and the claimed wherein the second information stream is arranged so that interaction with the first portion takes a period of time at least substantially equal to the duration of the advertisement.

Candelore suggests displaying an interactive message which a user needs to respond to ensure a user is actually viewing an infomercial before the user can receive a discount coupon (see col 12 lines 47-56, col 16 lines 19-39). It would have been

obvious to modify Candelore to include claimed second information stream is arranged so that interaction with the first portion takes a period of time at least substantially equal to the duration of the first information stream, whereby the user is induced to consume substantially the entire first information stream and to include the claimed wherein the second information stream is arranged so that interaction with the first portion takes a period of time at least substantially equal to the duration of the advertisement by providing interactive questions throughout the duration of the advertisement to ensure that the user views the entire infomercial thus benefiting both the user and advertiser.

Regarding claim 33, Candelore discloses a system which provides a user with viewing an interactive infomercial which is defined by Candelore as a type of commercial (see col 12 lines 10-22) wherein when a user views the entire commercial a coupon is provide to the user as a reward (see col 12 lines 10-22). It should be noted that the user must also interact with the system to ensure the user is viewing the infomercial (see col 12 lines 47-56, col 16 lines 28-39).

Candelore discloses the infomercial as the first information stream, a second information stream first portion is met by the question asking the viewer if he wishes to continue (see col 12 lines 46-56) and the second portion is met by the coupon (col 12 lines 10-22). It should be noted that consumption of use of the coupon is conditioned upon the user answering the question (see col 12 lines 46-56).

Candelore fails to disclose the claimed setup box. The Examiner takes Official Notice it would have been well known in the television art to utilize a compact setup box enabling user interactivity. Therefore, it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to modify Candelore to include the claimed settop box to enable user interactivity via a compact settop box.

Claim 6, 16, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (6,057,872) in view of Alpdemir (6,658,389).

Regarding claims 6, 16 and 27 Candelore fails to disclose wherein the entity is an audio entity.

Candelore discloses a video coupon as a video entity. Alpdemir teaches a system which provides a user with an audio coupon (see Abstract, col 2 lines 34-39, col 3 lines 10-15). It would have been obvious modifying Candelore to include audio coupons would have provided a user with an audio coupon which would have benefited both advertisers and users by enticing users to watch advertisements while also benefiting users by providing discount coupons. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Candelore to include audio coupons to benefit both users and advertisers.

Claims 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al (5,671,267).

Regarding claim 36, August fails to disclose the claimed the handset adapted to receive information streams from at least one of GPRS, UMTS, and Internet transmission media. The Examiner takes Official Notice it would have been well known to receive information streams on a handheld device from an Internet Service Provider

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(ISP) to enable access to vast amount information or a highly universal/compatible transmission system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify August to include the claimed limitation to enable access to a vast amount of information or a highly/universal compatible transmission system.

Claims 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (6,057,872) in view of August (5,671,267).

Considering claim 37, Candelore discloses a system which provides a user with viewing an interactive infomercial which is defined by Candelore as a type of commercial (see col 12 lines 10-22) wherein when a user views the entire commercial a coupon is provide to the user as a reward (see col 12 lines 10-22). It should be noted that the user must also interact with the system to ensure the user is viewing the informercial (see col 12 lines 47-56, col 16 lines 28-39) and that the user is prompted to enter a response (see col 12 lines 10-22). It should be also noted that Candelore discloses receiving the first information stream and a second receiving means since the second information stream is received from a separate communication medium (see col 5 lines 53-55).

Candelore fails to disclose the claimed settop box. The Examiner takes Official Notice it would have been well known in the television art to utilize a compact settop box enabling user interactivity. Therefore, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to modify Candelore to include the claimed settop box to enable user interactivity via a compact settop box.

Candelore fails to disclose the claimed Handset for capturing the second content conditionally according to the user's response to said prompting. August teaches a system in which a handset is using for retrieving electronic coupon information and advertiser information from a TV wherein the handset can retrieve the telephone number for an advertiser enable ease of dialing the advertiser (see col 3 lines 25-55). It would have been obvious modifying Candelore to include the claimed handset would have enabled a user to retrieve electronic coupon information directly from a broadcast and would enabled dialing the advertiser without having to write down the telephone number. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Candelore to include the claimed limitation to provide a quick means for retrieving coupon information and dialing and advertiser which would benefit both the user and the advertiser by providing a user with a discount and providing the advertiser with sales of its merchandise.

Regarding claim 38, since it would have been obvious to include a settop in Candelore (see claim 37), it would have been obvious to include the second receiving means in the settop.

Regarding claim 39, the combination of Candelore and August discloses the claimed limitation, wherein August discloses a second receiving means incorporated in the handset (see fig 2 item 213).

Regarding claim 40, since it would have been obvious to include a settop in Candelore (see claim 37), it would have been obvious to include the prompting means incorporated in the settop box.

Regarding claim 41, the combination of Candelore and August discloses a prompting means and handset. It would have been obvious to one skilled in the art to include a prompting means in the handset to have a single device for both prompting a user and for retrieving coupon information.

Regarding claim 42, the combination of Candelore and August fails to disclose wherein the handset is adapted to receive information streams from at least one of GPRS, UMTS and internet media.

The Examiner takes Official Notice it would have been well known to receive information streams on a handheld device from an Internet Service Provider (ISP) to enable access to vast amount information or a highly universal/compatible transmission system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify August to include the claimed limitation to enable access to a vast amount of information or a highly/universal compatible transmission system.

Allowable Subject Matter

Claims 8, 9, 18, 19, 20, 29, 30, 32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Henderson et al (5,603,078) – Remote control device with smart card

Hayes et al (6,223,348) – Remote Control which can store coupon data

De Rafael el al (6,529,878) – Rewarding viewers of interactive ads

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308- 5359 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Vivek Srivastava whose telephone number is (703) 305 - 4038.

The examiner can normally be reached on Monday - Thursday from 8:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andy Faile, can be reached at (703) 305 - 4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305 - 3900.

VS 1/7/04



**VIVEK SRIVASTAVA
PRIMARY EXAMINER**